

## **REMARKS/ARGUMENTS**

### **I. General Remarks.**

Applicants respectfully request that the above amendments be entered and further request reconsideration of the application in view of the amendments and the remarks contained herein.

### **II. Disposition of the Claims.**

Claims 1-42 are pending. Claims 1-42 stand rejected.

Claim 1 is amended herein. This amendment adds no new matter to the application, and is supported by the specification as filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants reserve their rights to take up prosecution on the claims as originally filed in this or an appropriate continuation, continuation-in-part, or divisional application.

### **III. Remarks Regarding Objection to Abstract.**

The Examiner objected to the Abstract “because the term ‘the present invention,’ is stated in lines 1 and 3.” (Office Action at 2.) While Applicants believe that the Abstract is in compliance with the *Manual of Patent Examining Procedure* (hereinafter “MPEP”) section 608.01(b), Applicants have amended the Abstract in accordance with the Examiner’s request. Accordingly, Applicants respectfully request withdrawal of this objection with respect to the Abstract.

### **IV. Remarks Regarding the Rejection of Claims 1-42 Under 35 U.S.C. § 102(b).**

#### **A. Claims 1-42 Are Not Anticipated by *Glowka*.**

The Examiner has rejected claims 1-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,343,968 issued to Glowka ( hereinafter “*Glowka*”). Applicants respectfully traverse. Applicants respectfully traverse because *Glowka* does not teach or suggest each and every limitation of claims 1-42 as required to anticipate the claims under 35 U.S.C. § 102(b). MPEP § 2131.

#### **1. *Glowka* Does Not Teach Every Element of Claims 1-38.**

In particular, independent claim 1 is allowable because *Glowka* does not disclose “a mixing chamber formed between the bottom end of the inner tubing and the bottom end of the outer tubing into which the first and second components of the sealant mixture combine to form

the sealant mixture.” The Office Action alleges that *Glowka* discloses “a mixing chamber formed between the bottom end of the inner tubing and the bottom end of the outer tubing into which the first and second components of the sealant mixture combine to form the sealant mixture.” (Office Action at 3.) However, rather than disclosing the recited mixing chamber, *Glowka* provides that “two slurry streams exit the injector in separate locations, then enter the loss zone and mix, thereby initiating the chemical reaction that hardens the mud into cement.” *Glowka*, Col. 5, ll. 10-12. Accordingly, it is clear that *Glowka* does not disclose a mixing chamber formed between the bottom end of the inner tubing and the bottom end of the outer tubing. Accordingly, *Glowka* does not disclose every element of independent claim 1.

Therefore, Applicants respectfully assert that independent claim 1 is not anticipated by *Glowka*. Accordingly, for at least this reason, independent claim 1 and its dependents, claims 2-14, should be allowed. Claims 15, 28, 31, and 35 and their dependents, claims 16-27, 29-30, 32-34, 36-38, should be allowed for analogous reasons.

**2. *Glowka* Does Not Teach Every Limitation of Claims 39-42.**

Furthermore, independent claim 39 is allowable because *Glowka* does not disclose “a method of preparing a cement composition comprising the steps of: mixing a first cementitious component and an aqueous-based fluid to form an intermediate cement composition in a first mixer; and mixing the intermediate cement composition and a second cementitious component in a second mixer to form the cement composition.” To the contrary, *Glowka* provides for a method “to allow the components of a two-component plugging material, such as cementitious mud, to be placed downhole simultaneously but separately, without mixing the components prior to emplacement in the wellbore, for lost circulation control.” *Glowka*, Col. 4, ll. 37-42. Nowhere does *Glowka* suggest a method which includes the step of mixing a first cementitious component and an aqueous-based fluid to form an intermediate cement composition in a first mixer. Accordingly, *Glowka* does not disclose every element of independent claim 39.

Therefore, Applicants respectfully assert that independent claim 39 is not anticipated by *Glowka*. Accordingly, for at least this reason, independent claim 39 and its dependents, claims 40-42, should be allowed.

**B. Claims 1-42 Are Not Anticipated by *Tokoro*.**

The Examiner has rejected claims 1-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,449,856 issued to Tokoro et al. (hereinafter “*Tokoro*”).

Applicants respectfully traverse because *Tokoro* does not disclose every element as recited in Applicants' claims 1-42 as required to anticipate the claims under 35 U.S.C. § 102(b). MPEP § 2131.

**1. *Tokoro* Does Not Teach Every Element of Claims 1-38.**

In particular, independent claim 1 is allowable because *Tokoro* does not disclose "a mixing chamber formed between the bottom end of the inner tubing and the bottom end of the outer tubing into which the first and second components of the sealant mixture combine to form the sealant mixture." The Office Action alleges that *Tokoro* discloses "a mixing chamber 48 formed between the bottom end of the inner tubing and the bottom end of the outer tubing into which the first and second components of the sealant mixture combine to form the sealant mixture." (Office Action at 5.) However, rather than disclosing the recited mixing chamber, *Tokoro* provides for "an annular mixing chamber formed between said outer pipe member and said inner pipe member to communicate with said one or more injection orifices and said exit port." *Tokoro*, Col. 3, ll. 30-33. The annular mixing chamber of *Tokoro* is thus not formed between the bottom end of the inner tubing and the bottom end of the outer tubing as recited in independent claim 1. *Tokoro*, Col. 3, ll. 30-33. Accordingly, *Tokoro* does not disclose every element of independent claim 1.

Therefore, Applicants respectfully assert that independent claim 1 is not anticipated by *Tokoro*. Accordingly, for at least this reason, independent claim 1 and its dependents, claims 2-14, should be allowed. Claims 15, 28, 31, and 35 and their dependents, claims 16-27, 29-30, 32-34, and 36-38, should be allowed for analogous reasons.

**2. *Tokoro* Does Not Teach Every Limitation of Claims 39-42.**

Additionally, independent claim 39 is allowable because *Tokoro* does not disclose "a method of preparing a cement composition comprising the steps of: mixing a first cementitious component and an aqueous-based fluid to form an intermediate cement composition in a first mixer; and mixing the intermediate cement composition and a second cementitious component in a second mixer to form the cement composition." However, *Tokoro* does not disclose this recitation. Rather, *Tokoro* provides for a method for:

[I]njecting a grout composed of a first liquid and a second liquid and curable when the liquids are combined, which comprises: feeding said first liquid through a peripheral portion of an injection pipe comprised of an inner pipe member and an outer pipe member

having one or more injection orifices formed in said sidewall thereof, in parallel with the axis of said injection pipe, to introduce said first liquid into an annular mixing chamber; feeding said second liquid to said inner pipe member to depress, by a pressure of the liquid, a spool valve fitted in said inner pipe member, so as to introduce said second liquid into said annular mixing chamber, combining, contacting and mixing the liquids in said annular mixing chamber;

*Tokoro*, Col. 2, ll. 48-61. Nowhere does *Tokoro* suggest a method which includes the formation of an intermediate cement composition in a first mixer and the mixing of a second cementitious component with the intermediate cement composition in a second mixer to form the cement composition. Accordingly, *Tokoro* does not disclose every element of independent claim 39.

Therefore, Applicants respectfully assert that independent claim 39 is not anticipated by *Tokoro*. Accordingly, for at least this reason, independent claim 39 and its dependents, claims 40-42, should be allowed.

**C. Claims 1-42 Are Not Anticipated by *Smith*.**

The Examiner has rejected claims 1-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,064,941 issued to Smith (hereinafter "*Smith*"). Applicants respectfully traverse because *Smith* does not disclose every element as recited in Applicants' claims 1-42 as required to anticipate the claims under 35 U.S.C. § 102(b). MPEP § 2131.

**1. *Smith* Does Not Teach Every Element of Claims 1-14.**

In particular, independent claim 1, as amended, recites "an inner tubing formed from a material comprising a ferrous metal and having at least one port disposed at a bottom end through which a first component of a sealant mixture is delivered downhole." However, *Smith* does not disclose this recitation. Rather, *Smith* provides that "the injection tool 60 comprises an enlarged outer shell or body portion 64 in which an elastic tube 66 is affixed with the tubular body 64, at its upper and lower ends." *Smith*, Col. 5, ll. 57-65. Thus, *Smith* discloses an elastic tube and not an inner tubing formed from a material comprising a ferrous metal. While *Smith* discloses that "the elastic tube 66 is reinforced longitudinally as with embedded longitudinal cloth or metal strips," *Smith* does not disclose that the elastic tube is formed from a material comprising a ferrous metal. *Smith*, Col. 5, ll. 57-65. Instead of being formed by a material comprising a ferrous metal, the tube disclosed in *Smith* "is expansible in diameter." *Smith*, Col. 5, ll. 57-65. Accordingly, nowhere does Smith disclose an inner tubing formed from a material

comprising a ferrous metal as recited in independent claim 1. Accordingly, *Smith* does not disclose every element of independent claim 1.

Therefore, Applicants respectfully assert that independent claim 1 is not anticipated by *Smith*. Accordingly, for at least this reason, independent claim 1 and its dependents, claims 2-14, should be allowed.

**2. *Smith* Does Not Teach Every Limitation of Claims 15-27.**

Regarding independent claim 15, this claim is allowable because *Smith* does not disclose a “means for orientating the downhole tool in a borehole.” The Office Action alleges that *Smith* discloses “means for orientating the downhole tool in a borehole. (Office Action at 4.) However, *Smith* does not disclose this recitation. Rather, *Smith* provides that:

[T]he injection tool 60 comprises an enlarged outer shell or body portion 64 in which an elastic tube 66 is affixed with the tubular body 64, at its upper and lower ends. The tube 66 is preferably affixed to the body 64 by rivets or bonding to the inner surface of the body 64 at 68 and may be suitably bonded to the base plate 70 at the bottom of the tubular body 64.

*Smith*, Col. 5, ll. 57-64. Nowhere does *Smith* disclose a means for orientating a downhole tool in a borehole. Accordingly, *Smith* does not disclose every element of independent claim 15.

Therefore, Applicants respectfully assert that independent claim 15 is not anticipated by *Smith*. For at least this reason, independent claim 15 and its dependents, claims 16-27, should be allowed.

**3. *Smith* Does Not Teach Every Element of Claims 28-38.**

Regarding independent claim 28, this claim is allowable because *Smith* does not disclose the steps of “pumping a first component of a sealant mixture through an inner tubing, the inner tubing having at least one port disposed at a bottom end through which the first component is discharged downhole from the inner tubing; [and] pumping a second component of the sealant mixture through an annulus formed between an outer tubing disposed around the inner tubing, wherein the annulus delivers the second component of the sealant mixture downhole.” Rather than disclosing the recited steps, *Smith* provides for:

[T]wo fluids in separate concentric containers and a ball positioned within the upper end of the tool in such a manner that it may be forced downwardly by fluid pressure exerted from the surface to expand the inner container as the ball moves down through the tool to force both fluids into a single chamber (which may contain and

in-line mixture) prior to injection of the mixture into a predetermined downhole interval in the formation.

*Smith*, Col. 2, ll. 38-46. Accordingly, *Smith* does not disclose every element of independent claim 28.

Therefore, Applicants respectfully assert that independent claim 28 is not anticipated by *Smith*. Accordingly, for at least this reason, independent claim 28 and its dependents, claims 29-30, should be allowed. Claims 31 and 35 and their dependents, claims 32-34 and 36-38, should be allowed for analogous reasons.

**4. *Smith* Does Not Teach Every Element of Claims 39-42.**

Furthermore, independent claim 39 is allowable because *Smith* does not disclose the steps of “mixing a first cementitious component and an aqueous-based fluid to form an intermediate cement composition in a first mixer; and mixing the intermediate cement composition and a second cementitious component in a second mixer to form the cement composition.” Rather than disclosing the recited steps, *Smith* provides a method for:

[A]dmixing two separated fluids at a downhole location by pumping the fluids through the well to the downhole location through a tubing extending into the well from the surface. Admixture of the two separated downhole fluids is effected from the concurrent discharge of the two fluids from separate chambers into a single chamber prior to injection into the formation.

*Smith*, Col. 2, ll. 4-11. Nowhere does *Smith* disclose a method which includes the steps of mixing a first cementitious component and an aqueous-based fluid to form an intermediate cement composition in a first mixer; and mixing the intermediate cement composition and a second cementitious component in a second mixer to form the cement composition. Accordingly, *Smith* does not disclose every element of independent claim 39.

Therefore, Applicants respectfully assert that independent claim 39 is not anticipated by *Smith*. Accordingly, for at least this reason, independent claim 39 and its dependents, claims 40-42, should be allowed.

**V. No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to

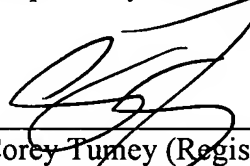
additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinction discussed by Applicant is sufficient to overcome the anticipation rejections.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0583.

Respectfully submitted,



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